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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

DUNWOODY, AARON M

ART UNIT

PAPER NUMBER

3679

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/849,635	Applicant(s) SHEMTOV, SAMI	
	Examiner Aaron M. Dunwoody	Art Unit 3679	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-16, 20-35 and 37-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-16, 20-35 and 37-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

Claims 22, 23, 26, 27, 30, and 31 are objected to because of the following informalities: These claims depend from canceled claims 17-19. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-16, 20-35, and 37-49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claims 38, 39, 42 and 46, appear to define the claimed invention of a coupling member, conduits and connecting member (sub-combination) in terms of the functional remote supporting structure. Applicant should amend claims to positively claim the sub-combination, or the combination of the functional remote supporting structure with a coupling member, conduits and connecting member.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in

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scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Applicant is advised that should claim 42 be found allowable, claims 2, 3, 6, 7, 33 and 38 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Applicant is advised that should claim 46 be found allowable, claims 21 and 39 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 2-16, 20-35, 37, 38, and 40-45 are rejected under 35 U.S.C. 102(b) as being anticipated by US patent 3493206, Albro.

In regards to claims 2-16, 20-35, 37, 38, and 40-45, as best understood, in Figures 1 and 3, Albro discloses a combination of a coupling member, an electrical wire-

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carrying conduit, and a connecting member for positioning and securing said conduit to a remote supporting structure (not shown but implied) above said coupling member, said combination comprising:

said electrical wire-carrying conduit having opposite ends;

said coupling member receiving and supporting said conduit, said coupling member comprises a tubular member having a longitudinal axis and at least one end, said end receiving one end of said conduit along said longitudinal axis, and said tubular member having a wall containing an aperture facing the remote supporting structure above said coupling member; and

said connecting member having opposite ends, one end of said connecting member securely engaging said aperture in said wall of said tubular member, the opposite end of said connecting member extending outwardly beyond said wall and upwardly toward said remote structure, and

a clamp assembly (17), said connecting member engaging a clamp assembly adapted to selectively and securely engage the remote supporting structure, to securely hold and support said coupling member and said conduit in a selected position, and to be removably engagable to said remote supporting structure.

Claims 2-16, 20-35, 37-41 and 46-49 are rejected under 35 U.S.C. 102(b) as being anticipated by US patent 2246557, Walters.

In regards to claims 2-16, 20-35, 37-41 and 46-49, as best understood, in Figures 1 and 3, Walters discloses a combination of a coupling member (7), a pair of electrical wire-carrying conduits (2, 2'), and a connecting member (25) for positioning and securing a said pair of conduits to a remote supporting structure (not shown but implied) above said coupling member, said combination comprising:

said pair of electrical wire-carrying conduits, each conduit having opposite ends; said coupling member receiving and supporting said conduits, said coupling member comprises an integral tubular member having a longitudinal axis and a generally cylindrical wall surrounding an interior space and opposed axially aligned ends, each of said ends having a longitudinal central axis and receiving one end of one of said pair of conduits along said longitudinal axis, and said tubular member having an aperture through said cylindrical wall into said interior space facing the remote supporting structure above said coupling member; and

said connecting member having opposite ends, one end of said connecting member securely engaging said aperture in said wall of said tubular member such that said end of said connecting member extends into said interior space to securely engage said ends of said conduits being received in said coupling member, the opposite end of said connecting member extending outwardly beyond said wall and upwardly toward said remote structure, and

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a clamp assembly (3), said connecting member engaging a clamp assembly adapted to selectively and securely engage the remote supporting structure, to securely hold and support said coupling member and said pair of conduits in a selected position, and to be removably engagable to said remote supporting structure.

Response to Arguments

Note, all claim limitations have been considered by the Examiner.

Applicant's arguments filed 1/12/2009 have been fully considered but they are not persuasive.

Applicant argues that the prior art has not been applied to all claims. The Examiner disagrees. All claim limitations are represented in the Figures of the prior art.

Applicant argues that claim 39 has not been rejected by Albro and therefore allowable. The Examiner disagrees. The Examiner is extremely confused by Applicant's arguments, because claim 39 has been rejected with Walters.

Applicant argues that the rejection is not complete. The Examiner disagrees. 37 C.F.R. 1.104(c)(2) recites:

(2) In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

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Applicant's invention is not complex, nor is the prior art, and the Examiner has described the invention as practicable because each reference clearly illustrates what is anticipated.

Applicant argues that the Examiner has failed to establish a *prima facie* case of anticipation. The Examiner disagrees. The Examiner has directed Applicant to the illustrations of the prior art, which clearly illustrate the claimed features.

Applicant argues that the prior art fails to disclose a coupling member. The Examiner disagrees. While anticipation requires the disclosure of each and every limitation of the claim at issue in a single prior art reference, it does not require such disclosure *in haec verba*. In re Bode, 550 F.2d 656, 660, 193 USPQ 12, 16 (CCPA 1977). In addition, it does not require that the prior art reference "teach" what the application at issue teaches. Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1983). Finally, Applicant is reminded that during examination claim limitations are to be given their broadest reasonable reading. In re Zletz, 893 F.2d 319, 321, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron M. Dunwoody whose telephone number is 571-272-7080. The examiner can normally be reached on 7:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on 571-272-7087. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Aaron M Dunwoody/
Primary Examiner, Art Unit 3679

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